

### REMARKS

This is a full and timely response to the outstanding Final Office Action mailed on August 27, 2003. Claims 1-48 remain pending in the present application, with claims 1-25 being currently amended. Reconsideration and allowance of the application and presently pending claims are respectfully requested in view of the following remarks.

Claims 1-48 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Lajoie* (U.S. Patent No. 5,850,218) in view of “*The Complete Idiot’s Guide to Windows 95, 2<sup>nd</sup> ed.*” (“*McFedries*”). *Lajoie* is directed to systems and methods related to television set-top terminals, whereas *McFedries* is directed to using Windows 95, an operating system for personal computers. The cited portion of *McFedries* is directed to using a Windows Explorer application, whereas the current invention is directed to television set-top terminals (STTs) configured to provide television program guides, and to related methods. The following are factors that to be considered in whether *McFedries* and *Lajoie* may properly be combined to reject the current claims, and whether the combination of *McFedries* and *Lajoie* render any of the pending claims obvious:

I- *McFedries* is directed to using Windows 95, an operating system for personal computers. For purposes of the present claims, a personal computer (PC) is substantially different than an STT (a limitation in the current claims). For example, as compared to an STT, a PC typically is more difficult to operate, has more computing resources, and has different input/output resources.

II- The portion of *McFedries* cited by the Office Action relates to using a Windows Explorer application. A Windows Explorer application is substantially different from a program guide application implemented by an STT to provide television program listings. For example, a Windows Explorer application is primarily a file management system, whereas a program guide application may be viewed by those reasonably skilled in the art as being a program listing viewing system (as of the effective filing date of the current application). Furthermore, as compared to a program guide application, a Windows Explorer application typically is more difficult to operate, is supported by more computing resources, is responsive to different input resources, and provides outputs via different output resources.

III- Files that are managed by a Windows Explorer application are substantially different from program listings provided by an STT. For example, files depicted by a Windows Explorer application typically represent data and/or software stored on a PC, whereas program listings provided by an STT typically represent television programs that are to be received by the STT. Furthermore, files depicted by a Windows Explorer application continue to be depicted by the Windows Explorer application for an indefinite period of time (e.g., until deleted by a user), whereas program listings provided by an STT change over time (i.e., older program listings are replaced by newer program listings as time goes by). As another example, unlike program listings depicted by an STT, files are typically depicted by a Windows Explorer application as icons that can be dragged and manipulated by a user.

Based on the foregoing, *McFedries* and *Lajoie* may not properly be combined to reject the current claims. Furthermore, the combination of *McFedries* and *Lajoie*, even if proper, do not render any of the pending claims obvious. For example, the combination of *McFedries* and *Lajoie* might suggest a system for managing files stored on an STT, but not the claimed invention. More specifically, in light of the foregoing factors, the rejection of the currently pending claims is traversed for the following reasons:

#### **A. Cited References Inadequate.**

Applicants respectfully traverse the rejection of claims 1-48 on the basis that combining *McFedries* (that teaches a method for modifying settings for Windows Explorer) with *Lajoie* (which discloses television program guides) would not render any of claims 1-48 obvious.

Applicants cite the following case-law in support of Applicants' traversal of the rejection of claims 1-48:

"The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art." In re Dow Chemical 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

"The test (for obviousness) is what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

"(T)he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed." Haitness International, Inc. v. Simplimatic Engineering Co., 819 F.2d 1100, 1108, 2 U.S.P.Q.2d 1826 (Fed Cir. 1987).

"Humans must work with old elements, most if not all of which win normally be found somewhere in an 'examination of the prior art.'" Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1549, 220 U.S.P.Q. 193 (Fed, Cir. 1983).

"That features, even distinguishing features, are 'disclosed' in the prior art is alone insufficient. As above indicated, it is common to find elements or features somewhere in the prior art. Moreover, most if not all elements perform their ordained and expected function. The test is whether the claimed invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made." Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 1549, 220 U.S.P.Q. 193 (Fed. Cir, 1983).

"Virtually all inventions are 'combinations', and.., every invention is formed of old elements' .... Only God works from nothing. Man must work with old elements". In re Wright 848 F.2d 1216, 6 U.S.P.Q.2d 1959, 1962 (Fed. Cir. 1988), overruled (on other grounds), 919 F.2d 688, 693, 16 U.S.P.Q.2d 1897, 1901.



#### **B. No motivation to combine references**

Applicants respectfully traverse the rejection of claims 1-48 on the basis that a person of ordinary skill in the art would not have been motivated to combine *Lajoie* and *McFedries*. *Lajoie* is directed to systems and methods related to television set-top terminals, whereas *McFedries* is directed to using Windows 95, an operating system for personal computers. There is no reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would combine *Lajoie* and *McFedries* to read on the claimed invention. Applicants cite the following case-law in support of Applicants' traversal of the rejection of claims 1-48:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc., v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 U.S.P.Q. 929, 933 (Fed Cir. 1984).

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." In re, Oetiker, 977 F.2d 1443,1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

Whether "one skilled in the art might find it obvious to try various combinations ... is not the standard." In re Geiger, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276 (Fed. Cir. 1987).

The PTO can satisfy its burden of establishing a *prime fade* case of obviousness "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596,1598 (Fed Cir. 1988).

"When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination." Heidelberger Druckmaschinen v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1072, 30 U.S.P.Q.2d 1377 (Fed. Cir. 1994).

"Moreover, the question is not simply whether the prior art 'teaches' the particular element of the invention, but whether it would 'suggest the desirability, and thus the obviousness, of making the combination.'" ALCO Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490,1498, 1 U.S.P.Q.2d 1337, 1343 (Fed. Cir. 1986).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co, 730 F.2d 1452,1462, 221 U.S.P.Q. 481 (Fed. Cir. 1984).

### **C. Lack of Suggested Desirability of Modification in Cited References**

Applicants respectfully traverse the rejection of claims 1-48 on the basis that *McFedries* does not suggest the desirability of modifying *Lajoie* in a manner that reads on any of claims 1-48. More specifically, *McFedries* does not suggest to a person of ordinary skill in the art the desirability of modifying the television program guide systems and methods disclosed in *Lajoie* in a manner that renders any of the pending claims 1-48 obvious. Applicants cite the following case-law in support of Applicants' traversal of the rejection of claims 1-48:

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re, Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

"Modification unwarranted by the disclosure of a reference is improper" Carl Schenck, A.G. v. Nortron Corp., 713 F.2d 782, 218 U.S.P.Q. 698, 702 (Fed Cir. 1983).

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992).

#### **D. Non-Analogous Art**

Applicants respectfully traverse the rejection of claims 1-48 on the basis that *McFedries* and *Lajoie* correspond to non-analogous arts. More specifically, *McFedries* relates to operating systems for personal computers, whereas *Lajoie* relates to cable television systems. Applicants cite the following case-law in support of Applicants' traversal of the rejection of claims 1-48:

"The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." Application of Wood, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979).

"The rationale behind this rule precluding rejections based on combination of teachings of references from nonanalogous arts is the realization that an inventor could not possibly be aware of every teaching in every art" Application of Wood, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171 (C.C.P.A. 1979).

"References that are not within the field of the inventor's endeavor may also be relied on in patentability determinations, and thus are described as 'analogous art', when a person of ordinary skill would reasonably have consulted those references and applied their teachings in seeking a solution to the problem that the inventor was attempting to solve," Heidelberger Druckmaschinen v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 1071, 30 U.S.P.Q.2d 1377 (Fed Cir. 1994).

#### **E. Hindsight**

Applicants respectfully traverse the rejection of claims 1-48 on the basis that claims 1-48 may have only been obvious in hindsight to a person of ordinary skill in the art (*i.e.*, only after

reading the Applicants' disclosure). Applicants cite the following case-law in support of Applicants' traversal of the rejection of claims 1-48:

"Prior art may not be gathered with the claimed invention in mind." Pentec, Inc. v. Graphic Controls Corp., 776 F.2d 309, 227 U.S.P.Q. 766, 768-9 (Fed. Cir. 1985).

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

"This court has made it clear, moreover, that an invention will not be denied a patent because it embodies a solution which seems simple and obvious with the benefit of hindsight." Saf-gard Products, Inc. v. Service Parts, Inc., 532 F.2d 1266, 1272, 190 U.S.P.Q. 455 (9th Cir. 1976), cert. denied, 429 U.S. 896.

"(A) court must be careful not to declare an innovation obvious because it has become obvious through hindsight." Roberts v. Sears, Roebuck & Co., 723 F.2d 1324, 1334, 221 U.S.P.Q. 504 (7th Cir. 1984).

"It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (Fed. Cir. 1991).

"(T)here must be some reason for the combination other than the hindsight gleaned from the invention itself." Interconnect Planning Corp. v. Feil 774 P.2d 1132, 1143, 227 U.S.P.Q. 543 (Fed. Cir. 1985).

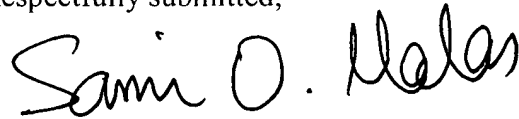
"Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." In re Dow Chemical 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Notwithstanding the foregoing arguments, the currently pending claims may still be construed to set forth systems and methods that comprise or that may be implemented by a personal computer configured to operate as an STT.

**CONCLUSION**

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-48 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink that reads "Sami O. Malas". The signature is written in a cursive, flowing style. The first name "Sami" is followed by a middle initial "O." and the last name "Malas".

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